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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,825	07/01/2003	Julio H. Monroig	200205243-1	3058

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HEWLETT-PACKARD DEVELOPMENT COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SMITH, JAMES G

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,825	Applicant(s) MONROIG ET AL.	
	Examiner James G. Smith	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 22-30, 42 and 43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 and 33 is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 15-21, 31, 32 and 36-41 is/are rejected.
- 7) ☒ Claim(s) 2, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 22-30, 42 and 43 drawn to an invention nonelected without traverse in the paper filed 20 September 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4 and 5 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to what is meant by "a stopper disposes in said recess", as it appears that this is a method step in the assembly process of the tool. Should "disposes" be - -disposed- -? If this is so, then claims 4 and 5 should be amended and they would be allowable.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 3, 6-9, 11, 15, 31, 32, 36 and 37 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Witmer as it shows a stopper that merely slides into the socket body and is therefore "adjustable".

6. Claims 18-21 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sabo which shows a "stopper" (44) that limits the insertion of the workpiece, i.e. a piece of pipe that "fastens" to some type of element and is therefore broadly a "fastener".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10, 16, 17 and 38-41 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Witmer.

Witmer shows the claimed invention except for the use of specific materials of construction and the exact size of the hex opening, claims 40 and 41. It would be obvious, however, to one skilled in the art at the time the invention was made to modify Witmer by using any well known material to make the socket body and to size the hex opening to fit any desired workpiece.

Allowable Subject Matter

9. Claims 2, 34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 12-14 and 33 are allowed.

Response to Arguments

11. Applicant's arguments filed 20 December 2004 have been fully considered but they are not persuasive.

Amended claims 42 and 43 are now drawn to the Group II invention that was nonelected without traverse and are therefore now withdrawn from consideration.

Claim 4 apparently has a typographical error and may be easily corrected to render it allowable.

With respect to the rejection of claims as anticipated by Witmer, applicants argue that the reference clearly does not have an adjustable stopper that has varies ranges, however from the disclosure of the reference it is apparent that as the stopper (30) is loosely fitted into the socket body and is thus "adjustable" to various longitudinal positions depending upon the length of the nut fit into the socket. As this is all that is claimed in claims 1, 3, 6-9, 11, 15, 31, 32, 36 and 37, they are anticipated by the reference.

Further, claims 10, 16, 17 and 38-41 merely add specific materials of construction and size limitations that pertain to specific workpieces, however one skilled in the art would clearly find it obvious to make the tool of Witmer of any well

known material, as alloys and stainless steel are well known tool art and to size any to or part thereof to fit an intended operation is also obvious.

With respect to claims 18-21 rejected as anticipated by Sabo, applicants argue that the patent does not show the claimed method of securing or loosening a "fastener" without damage to the surrounding area, however this is also in error as the reference clearly has an adjustable threaded stopper (20) whose position within the driver member (32) is adjustable by means of the member (44) and it is used to fasten one threaded "fastener" (30) onto another workpiece, which is all that these claims recite. The reference thus clearly anticipates the claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

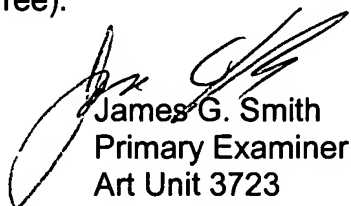
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G. Smith whose telephone number is 571-272-4496. The examiner can normally be reached on M-Th (7:05- 4:35) Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James G. Smith
Primary Examiner
Art Unit 3723

jgs
2/15/05